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| APPLICATION NO.                                                                   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/001,937                                                                        | 10/25/2001  | Christopher R. Ralph | 1759.17239-FOR      | 8882             |
| 7590 11/15/2005                                                                   |             |                      | EXAMINER            |                  |
| RYAN KROMHOLZ & MANION, S.C.<br>Post Office Box 26618<br>Milwaukee, WI 53226-0618 |             |                      | RAMANA, ANURADHA    |                  |
|                                                                                   |             |                      | ART UNIT            | PAPER NUMBER     |
|                                                                                   |             |                      | 3733                |                  |
| DATE MAILED: 11/15/2005                                                           |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                               |                              |  |
|------------------------------|-------------------------------|------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/001,937 | Applicant(s)<br>RALPH ET AL. |  |
|                              | Examiner<br>Anu Ramana        | Art Unit<br>3733             |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-13 and 17-24 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-13 and 17-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 21, 2005 has been entered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

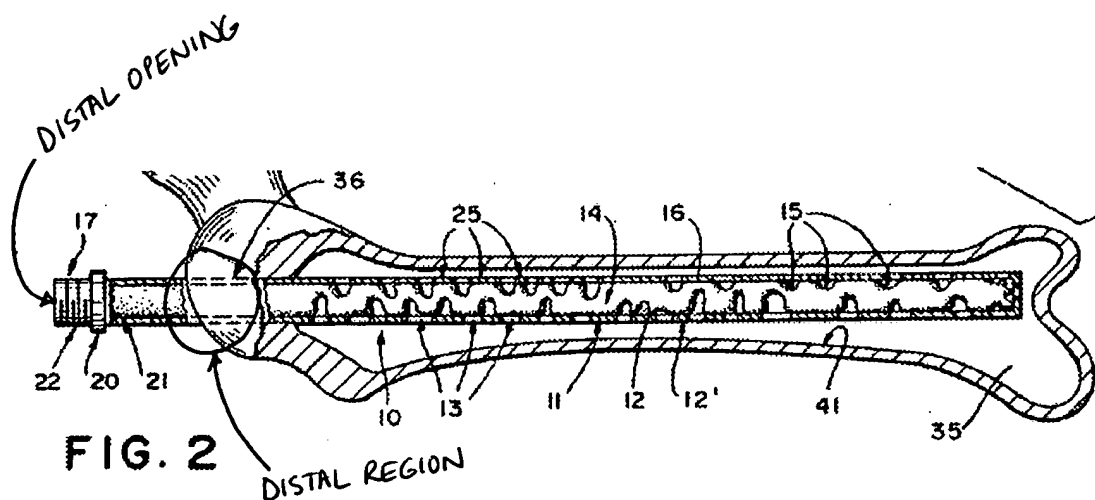
Claims 10-13 and 17-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Poddar (US 5,102,413).

Regarding claims 10-13 and 17-24, Poddar discloses a method including the steps of: (1) providing a hollow support rod or "cannula" 11 configured for insertion into a bone 4 wherein cannula 11 has a bore with an inner surface 12, at least one oval aperture 13 or "an aperture elongated along an axis of the bore," a distal region of cannula 11 being anchored in cortical bone and a distal opening in the distal region communicating with the bore; (2) inserting cannula 11 into cancellous bone; (3) inserting a bladder or "expandable structure" 14 into the bore of cannula 11 and into registration with the at least one opening 13; and (4) expanding the bladder 14 from within the bore through the at least one opening 13 into contact with cancellous bone to compact cancellous bone (Figure 2 and col. 3, lines 24-68). Also see marked up Figure 2 from Poddar on the following page.

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With regard to the limitations, "configured to establish a path into bone," "to anchor the distal region in cortical bone," and "to accommodate passage of a guide pin," it has been held that the recitation that an element is adapted to perform a function is not a positive limitation but only requires the ability to so perform and does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Regarding claims 13, 20 and 24, Poddar further discloses that surfaces 15 of bladder 14 may be coated with an adhesive layer or "material" 31 (Figure 4 and col. 4, lines 1-11). Thus, material 31 is conveyed into the cavity by expansion of the expandable structure 14 through the at least one opening 13.



### ***Response to Arguments***

Applicant's arguments submitted under "REMARKS," in the response filed on October 21, 2005, with respect to claims 10 to 13 and 17 to 24 have been considered.

Applicants' amendments to claims 17-24 have overcome the rejections under 35 U.S.C 112 second paragraph made in the office action mailed on April 19, 2005.

The Terminal Disclaimer submitted by Applicants on October 21, 2005 has been approved. Accordingly, the double patenting rejections of claims 10-13 and 17-24 made in the office action mailed on April 19, 2005 have been overcome.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR  
November 13, 2005

*Anuadha Ramana*  
AU 3733